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In re Application of :
DZHAVAKHIA et al. :
Serial No.: 10/583,066 : Decision on Petition
Filed: October 6, 2006 :
Attorney Docket No.: Korpela MF3 :

This letter is in response to the petition filed under 37 C.F.R. § 1.144 filed on October 20, 2008 requesting reconsideration of the restriction and/or lack of unity requirement. The delay in acting upon this petition is regretted.

BACKGROUND

This application was filed as a national stage application under 35 USC 371 of PCT/FI04/00766 and as such, is eligible for unity of invention practice.

On March 6, 2008, the examiner mailed to the applicant a restriction requirement under 35 USC 121 and 372 requiring applicant to elect between

- Group I, claims 1, 3-4, 8-9, and 11-13, drawn to a MF3 polypeptide, a composition comprising the polypeptide, and a method of using the polypeptide;
- Group II, claims 2, 5-7, and 14-15, drawn to DNA encoding MF3, a vector comprising the DNA, and a plant/cell transformed with the DNA; and
- Group III, claim 10, drawn to a method of isolating and purifying the MF3 polypeptide.

The examiner reasoned that the claimed inventions failed to share a special technical feature, since the Djavakhia et al. (US 6,528,480), disclosed an MF2 polypeptide which meets the limitations of the recited functional derivative of MF3 polypeptide.

On April 4, 2008, applicants elected, with traverse, Group II, arguing that Djavakhia et al. disclosed a protein that did not share specific characteristics with the instantly disclosed polypeptide.

On July 22, 2008, the examiner mailed to applicants a non-final Office Action. In the action, the examiner considered applicants' traversal of the restriction requirement and found them unpersuasive because they were directed to features that were not claimed. The examiner made the restriction requirement final. Claims 1, 3-4, and 8-13 were withdrawn from consideration as being directed to a non-elected invention. The following objections and rejections were made:

- 1) Claims 2, 5-7, and 14-15 were objected to as depending from a withdrawn claim.
- 2) Claims 2, 5-7, and 14-15 were rejected under 35 USC 112, second paragraph, as being indefinite.
- 3) Claims 2, 5-7, and 14-15 were rejected under 35 USC 112, first paragraph, for scope of enablement.
- 4) Claims 2, 5-7, and 14-15 were rejected under 35 USC 112, first paragraph, for failing to comply with the written description requirement.
- 5) Claims 2, 5-7, and 14-15 were rejected under 35 USC 102(b) as being anticipated by Djavakhia et al. (WO 97/05165).

On October 20, 2008, applicants submitted a response including the instant petition, amendments to the claims and specification, and remarks traversing the objection and rejections.

DISCUSSION

The petition and file history have been carefully considered.

Claim 1, as amended in the response received October 20, 2008, appears below:

1. (Currently amended) A bioactive polypeptide, MF3, with a primary structure depicted in SEQ ID NO: 1, or an active fragment of MF3 according to SEQ ID NO: 3 or SEQ ID NO:4, or any functional derivative of MF3, said polypeptide, or active fragment or functional derivative being capable of effecting a resistance of a plant against microbial diseases and/or against attack of plant parasites.

The petition correctly states that Djavakhia et al. (US 6,528,480) does not teach the claim as now amended.

Relevant sections of PCT International Search and Preliminary Examination Guidelines (published January 2004) state

Whether or not any particular technical feature makes a "contribution" over the prior art, and therefore constitutes a "special technical feature," is considered with respect to novelty and inventive step. (paragraph 10.02)

In this instance, a lack of unity cannot be maintained based on the failure of the claimed invention to make a contribution over the prior art. Therefore, the restriction requirement must be withdrawn.

DECISION

The petition is **GRANTED** for the reasons set forth above.

The restriction requirement set forth between Group I, II and III is withdrawn.

The application will be forwarded to the examiner for further action consistent with this decision and for consideration of the papers filed October 20, 2008.

Should there be any questions about this decision, please contact Special Program Examiner Julie Burke, by letter addressed to Director, Technology Center 1600, at the address listed above, or by telephone at 571-272-1600 or by facsimile sent to the general Office facsimile number, 571-273-8300.

A handwritten signature in black ink, appearing to read "Michael D. Wityshyn".

Mike Wityshyn
Acting Director, Technology Center 1600